

REMARKS

Claims 1-21 and 23-32 are all the claims pending in the application. By this Amendment, Applicant amends claims 1, 8, 15, and 27 to further clarify the invention and claims 5, 12, and 19 for improved conformity with the U.S. practice. Applicant further cancels claim 22 without prejudice or disclaimer and adds claim 32, which is clearly supported throughout the specification.

I. Summary of the Office Action

The Examiner withdrew the previous grounds of rejection and reopened prosecution. In particular, claim 22 is rejected under 35 U.S.C. § 102(e) and claims 1-21 and 23-31 are rejected under 35 U.S.C. § 103(a).

II. Claim Rejections under 35 U.S.C. § 102(e)

Claim 22 under 35 U.S.C. § 102(e) as being anticipated by a newly found reference, U.S. Patent No. 6,480,725 to Cassidy (hereinafter “Cassidy”). Applicant respectfully traverses these grounds of rejection at least in view of the following exemplary comments.

Since claim 22 has been cancelled, the rejection under 35 U.S.C. § 102(e) is rendered moot. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection.

III. Claim Rejections under 35 U.S.C. § 103(a)

Claims 1, 2, 4-9, 11-16, 18-21, and 23-31 under 35 U.S.C. § 103(a) as being obvious over Cassidy in view of U.S. Patent No. 6,029,065 to Shah (hereinafter “Shah”). Applicant respectfully traverses these grounds of rejection *at least* in view of the following exemplary comments.

Of these rejected claims, only claim 1, 8, 15, 23, and 27 are independent. This response at least initially focuses on independent claim 1, which recites *inter alia*: means for storing at least one set of protected primary provisioning data that cannot be updated without the intervention of the terminal user; wherein a connection to the data network is set up using the selected set of provisioning data, and wherein the protected primary providing data is information establishing a connection to the data network in a home access network.

In an exemplary, non-limiting embodiment, a terminal device may change or roam between users or access networks without losing the provisioning data. In an exemplary, non-limiting embodiment, a terminal may return to the home access network or the particular user without carrying out any further provisioning. That is, a terminal is provided with protected provisioning data that is stored in a storage area of the terminal and is not updated automatically (*see* page 4, lines 2 to 9 of the specification). Accordingly, when the user returns from a visiting network to a home network area, the protected provisioning data is used without requiring the terminal to again obtain the provisioning data for the home network area. It will be appreciated that the foregoing remarks relate to the invention in a general sense, the remarks are not necessarily limitative of any claims and are intended only to help the Examiner better understand the distinguishing aspects of the claims mentioned above.

Cassidy discloses a telephone with a memory (6) for storing first information, such as ID information and a memory module receiver (10) for removably receiving a memory module such as a SIM card for storing second information, such as ID information. In Cassidy, the telephone detects a change in contact between the memory module and the memory module receiver (10) since the previous use of the telephone. The first information is used when the memory module is provided and receiving means are not in contact and the second information is used when the

memory module and the receiving means are in contact while there is no change detected. However, in Cassidy, when a change is detected, the information to be used by the terminal is selected, either automatically or manually (*see* Abstract; col. 2, line 9 to col. 3, line 17 and col. 6, line 49 to col. 7, line 12).

Accordingly, in Cassidy, the telephone has a dual identity by including both means for storing its own identification (ID) information and means for removably receiving a memory module for storing, for example, subscriber identification information as such the manufacturer only needs to manufacture one type of phone which can be used on both the ID and the SIM networks. Network operators can provide an extra service to their subscribers by introducing the other identification method to provide a dual ID/SIM network. In addition, the user is provided with greater flexibility as he can use the phone on the current sole ID networks and SIM networks, as well as any introduced dual ID/SIM networks or can have separate accounts and data, one on the telephone ID and one on the memory module (col. 2, lines 15 to 67).

Cassidy, however, simply discloses storing number assignment module (NAM) data. Cassidy does not disclose or even remotely suggest that the protected data is provisioning data of the home access network. That is, Cassidy relates to providing users with several accounts so that the telephone can work with and/or without the SIM card and is unrelated to roaming between various networks and primary provisioning data for various networks. Shah does not cure the above-identified deficiency of Cassidy.

In addition, as acknowledged by the Examiner, Cassidy does not disclose or even remotely suggest protected provisioning data that cannot be updated without intervention by the user. The Examiner, however, alleges that Shah cures this deficiency of Cassidy (*see* page 4 of the Office Action). Applicant respectfully disagrees.

Shah teaches allowing a user to access features such as call waiting, conference calling, etc., by using the feature codes the subscriber is accustomed to (col. 1, lines 18 to 21, col. 4, lines 10 to 27). The feature codes are usually a numeric sequence, e.g. *69 (col. 1, lines 26 to 39). The feature codes vary from network to network. Therefore, if the user is in a visiting network, he or she is unable to access the feature codes of the home network (col. 1, lines 40 to 58). To enable the user to use the familiar feature codes of the home network, Shah discloses that when a mobile station (MS) accesses a visiting network, after the MS is registered, the feature codes of the visiting network are downloaded into the MS, for example, into the MS's temporary memory (col. 2, line 32 to col. 3, line 9). As a result, when the user wants to activate or deactivate a certain feature code, the MS matches the feature code of the home network with the downloaded feature code of the visiting network and forwards the feature code of the visiting network to the base station (col. 4, lines 10 to 27). In other words, Shah discloses feature codes which are numeric sequences such as *69 and does not suggest primary provisioning data.

The feature codes of Shah are used to provide the user with access (activation) to the phone features and not with access to the data network (col. 8, lines 32 to 40). In short, Shah does not cure the above-identified deficiencies of Cassidy in that it fails to disclose or suggest protected primary provisioning data that cannot be updated without the intervention of the user terminal and is used to access the data network.

In addition, one of ordinary skill in the art would not have and could not have combined the references in the manner suggested by the Examiner. "[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to

their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007). The *KSR* court warned that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.” 127 S. Ct. at 1743.

The Examiner alleges that one of ordinary skill in the art would have been motivated to include the update of the extended feature codes of Shah into the disclosure of Cassidy to enable ready access to network features across multiple networks without requiring the user to learn additional feature codes (*see* page 4 of the Office Action). However, this does not provide a reason for incorporating updates of extended feature codes as disclosed in Shah. If one of ordinary skill in the art would have combined the references for the reasons suggested by the Examiner then the feature codes of the home network would be matched with the feature codes of the visiting network. This, however, does not provide any reason for including the update of the extended feature codes.

Furthermore, if the two references were combined in the manner suggested by the Examiner, then the feature codes would be updated with user input and not the primary provisional data. Unlike the feature codes, the primary provisioning data is necessary to obtain any kind of service. Accordingly, confirming that the user is willing to pay for the primary provisioning data (as opposed to extended features) would be redundant at least because the user agrees to pay the basic fee when he subscribes to the telephone service. In short, Applicant

respectfully submits that one of ordinary skill in the art would not have and could not have combined the references in the manner suggested by the Examiner without exercising impermissible hindsight.

Therefore, “means for storing at least one set of protected primary provisioning data that cannot be updated without the intervention of the terminal user; wherein a connection to the data network is set up using the selected set of provisioning data, and wherein the protected primary providing data is information establishing a connection to the data network in a home access network,” as set forth in claim 1 is not suggested by the combined disclosures of Cassidy and Shah, which lack having protected primary provisioning data that cannot be updated without intervention of the terminal user and is information establishing a connection to the data network in a home access network. For at least these exemplary reasons, claim 1 is patentable over Cassidy in view of Shah. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection of claim 1. Claims 2, 4-7, 25, 26, and 29 are patentable at least by virtue of their dependency on claim 1.

Independent claims 8, 15, and 27 recite features similar to, although not necessarily coextensive with, the features argued above with respect to claim 1. Therefore, arguments presented with respect to claim 1 are respectfully submitted to apply with equal force here. For at least substantially analogous exemplary reasons, independent claims 8, 15, and 27 are patentable over Cassidy in view of Shah. Claims 9, 11-14, 16, 18-21, and 28, are patentable at least by virtue of their dependency on claim 8, 15, or 27.

In addition, independent claim 8 recites: “wherein the protected primary providing data is information establishing a connection to the data network in a home access network and current set of provisioning data comprises roaming information establishing a connection to the data

network in a visiting access network.” The combined disclosures of Cassidy and Shah fail to disclose or even remotely suggest that the information in the SIM card is roaming information for establishing a connection with the data network in the visiting access network. For at least these additional exemplary reasons, claim 8 is patentable over Cassidy in view of Shah.

In addition, dependent claim 28 recites: “wherein, when the terminal returns to a home access network, said one of said at least one set of protected primary provisioning data is copied from the protected storing means into the current storing means and wherein, the current set of primary provisioning data is downloaded from an access network provider in a visiting network.” The Examiner alleges that Cassidy discloses these unique features of claim 28 (*see* page 9 of the Office Action). Applicant respectfully disagrees. Applicant respectfully submits that Cassidy does not disclose or even remotely suggest copying data in the phone into a SIM card or vice versa. Furthermore, Cassidy does not disclose or even remotely suggest copying when the phone returns to the home network and downloading from the provider current set of provisioning data when in the visiting network. Shah does not cure the above-identified deficiencies of Cassidy. For at least these additional exemplary reasons, claim 28 is patentable over Cassidy in view of Shah.

Independent claim 23 *inter alia* recites: “when said protected provisioning data is not detected, requesting current provisioning data;...wherein before storing in said storage said protected provisioning data, the user is queried whether said protected provisioning data is to be stored.” Cassidy does not disclose or even remotely suggests requesting for download provisioning data when the SIM card (alleged protected provisioning data is not detected). Cassidy only discloses four possible scenarios in which either the SIM card information or the internal ID information is used (col. 8, lines 17 to 54). Cassidy, however, fails to disclose or

even remotely suggest requesting for the downloading provisioning data when the SIM card is not detected. Furthermore, Cassidy is unrelated to storing of the provisioning data and does not disclose or even remotely suggest before storing in said storage said protected provisioning data, the user is queried whether said protected provisioning data is to be stored. Shah does not cure the above-identified deficiencies of Cassidy. For at least these exemplary reasons, claim 23 is patentable over Cassidy in view of Shah. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection of claim 23 and its dependent claims 24, 30, and 31.

In addition, dependent claim 30 recites: “wherein, when the current provisioning data is requested, the terminal downloads the current provisioning data from a service provider and the terminal establishes a connection with the data network using the current provisioning data.” In Cassidy, contrary to the Examiner’s allegations (*see* page 9 of the Office Action), there is no disclosure or suggestion of downloading current provisioning data from the service provider and establishing the connection with this data. Shah does not cure the above-identified deficiencies of Cassidy. For at least these additional exemplary reasons, claim 30 is patentable over Cassidy in view of Shah.

Claims 3, 10, and 17 under 35 U.S.C. § 103(a) as being obvious over Cassidy and Shah in view of U.S. Patent No. 6,671,522 to Beaudou (hereinafter “Beaudou”). Applicant respectfully traverses these grounds of rejection at least in view of the following exemplary comments.

Claims 3, 10, and 17 depend on claims 1, 8, and 15, respectively. Applicant has already demonstrated that Cassidy and Shah do not meet all the requirements of independent claims 1, 8, and 15. Beaudou is relied upon only for its alleged disclosure of a packet switched data network and as such do not cure the above-identified deficiencies of Cassidy and Shah. Together, the combined teachings of these references would not have (and could not have) led the artisan of

ordinary skill to have achieved the subject matter of claims 1, 8, and 15. Since claims 3, 10, and 17 depend on claims 1, 8, and 15, they are patentable at least by virtue of their dependency.

IV. New Claim

In order to provide more varied protection, Applicant adds claim 32, which is patentable by virtue of its dependency and for additional features set forth therein.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. **If any points remain in issue, the**

Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below to set up an Interview.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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23373

CUSTOMER NUMBER

Date: March 24, 2008